

REMARKS/ARGUMENTS

This Response is in reply to the Office Action mailed on July 27, 2006. Claims 1-24 remain in this application. Claims 1-11, 16 and 18-24 stand withdrawn. The Examiner did not expressly state that claims 23 and 24 are withdrawn, but Applicant is assuming that this is the status of these two claims. Claims 12-15 and 17 stand rejected. Claims 12, 13 and 17 have been amended. Claims 14 and 15 have been canceled. Claims 1-13 and 16-24 are pending. Reconsideration of the present application in view of the above amendments and the following remarks is respectfully requested.

The Examiner restricts the present application to claims directed to the following patentably distinct species:

- A. Figures 4A, B
- B. Figures 4C, D
- C. Figures 4E, F
- D. Figures 4G
- E. Figure 5
- F. Figure 6
- G. Figures 7A, B
- H. Figure 7C
- I. Figures 8, 9
- J. Figure 10
- K. Figures 11, 12

Applicant elected Species G, Figures 7A and 7B for further prosecution on the merits in the present application.

The Examiner states that because the specification describes the device in Figure 5 as a separate embodiment from the device in Figure 7a, the restriction requirement is deemed proper and is made final.

However, Applicant maintains that the description of each embodiment of the present invention is not meant to stand alone. In other words, as Applicant expressly stated on page 12 of the originally filed specification the “[s]ubstitution of elements from one described embodiment to another are also fully intended and contemplated.” Thus, as described on page 4 of the original specification, “[t]he forceps can also be electrically charged as electro-surgical forceps.” As further evidence that Applicant contemplated that the embodiment of Figure 7A can be electrically charged as electro-forceps, one need only look to dependent claim 16, which depends indirectly from independent claim 12, and recites that the forceps are electrically charged.

Using the Examiner’s logic, Applicant would forever be prevented from drafting claims to the Figure 7A and 7B embodiment with the forceps being electro-surgical forceps. Such a logic cannot be sanctioned.

Thus, this Election of Species requirement is, once again, respectfully traversed. Applicant’s maintain that the use of an electro-surgical structure can be used with any of the disclosed mechanisms for articulation. Thus, Applicant’s respectfully request that Embodiments E and F be withdrawn from the species request, or that at a minimum, amended claim 12 be considered in the present application.

Claims 13-16 stand rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that applicant regards as the invention. More specifically, the Examiner noted that claim 13 requires a single bolt to pass through both blades 102, 202, but the species in Figure 7A and 7B has separate bolts. Applicant’s agree with the Examiner and have amended the claims above to make it clear that there are separate bolts for each blade.

Claims 12-15 and 17 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 3,818,784 to McClure.

This rejection is respectfully traversed in view of amended claim 12. Claim 12 recites that the forceps are electro-surgical forceps and that at least one electrical terminal is electrically connected to one of the first blade and the second blade. In addition, an insulator

is disposed between the first blade and the second blade to electrically isolate the first blade from the second blade.

Such a structure is neither taught nor suggested by McClure. McClure is directed to a pair of changeable tip tweezers, and as such has an integral one-piece heel end 16. Thus, heel end 16 is in electrical contact with both blades 14 of McClure's tweezers 10. To electrically isolate McClure's arms 14 from each other would destroy the basic teaching of McClure, and, thus, one of ordinary skill in the art would not have been led to such a modification of McClure's tweezers. Therefore, the present invention as exemplified by independent claim 12 is allowable.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Examiner is requested to contact the undersigned to discuss this application if doing so would facilitate the examination.

Respectfully submitted,

By: /Eugene L. Szczecina, Jr./

Eugene L. Szczecina, Jr.
Reg. No. 35,029

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-1479
Dated: October 27, 2006